



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,567	09/25/2003	Arthur J. Kover	195-001	4010
Steven S Payne 6027 ILIFF Drive Dunn Loring, VA 22027				
7590 03/17/2010				
EXAMINER				
VAN BRAMER, JOHN W				
ART UNIT		PAPER NUMBER		
3622				
MAIL DATE		DELIVERY MODE		
03/17/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/669,567

Applicant(s)

KOVER ET AL.

Examiner

JOHN VAN BRAMER

Art Unit

3622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed on November 6, 2009 cancelled claims 1-16. New claims 17-28 were added. Thus the currently pending claims addressed below are Claims 17-28.

Claim Rejections - 35 USC § 101

2. The amendment filed on November 6, 2009 cancelled Claims 1, and 4-8, thereby overcoming the 35 U.S.C. 101 rejection of said claims detailed in the Office Action dated August 4, 2008. Thus the examiner hereby withdraws the rejection.

3. Claims 17-22 are rejection under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the method steps are neither tied

Art Unit: 3622

to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing. The claims are directed towards collecting data and posing a question. Each of these steps could be performed manual and do not require that any specific apparatus is required. A conversation between two individuals could conceivably conduct all of the required steps of the claimed invention and thus no apparatus would be necessary.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 17-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Lesandrini et al. (PGPUB US 2002/0042733 A1).

Claims 17 and 23: Lesandrini discloses a method and system for obtaining web-based advertising research data over a communications system, comprising the steps of:

- a. Displaying at least one advertisement on a website. (Fig. 9; Fig. 11, Paragraphs [0037], [0076] through [0100], [0104], [0224], [0387] through [0402], [0514], and [0518])

- b. Requesting at least one user to react to the advertisement by pointing and clicking on at least one feature of the advertisement that is being displayed. (Fig. 9; Fig. 11, Paragraphs [0037], [0076] through [0100], [0104], [0224], [0387] through [0402], [0514], and [0518])
- c. Storing said point and click data, wherein the point and click data comprises at least one of location of at least one feature in the advertisement with a greater impact and location of first feature noticed in the advertisement. (Fig. 9; Fig. 11, Paragraphs [0037], [0076] through [0100], [0104], [0224], [0387] through [0402], [0514], and [0518])
- d. Posing at least one question to said at least one user based on said collected point and click data. (Paragraphs [0076] through [0100] and Paragraphs [0387] through [0402])

Claims 18 and 24: Lesandrini discloses the method and system according to claims 17 and 23, wherein a feature is a word, phrase, object, person, animal, or scene depicted in the advertisement. (Fig. 9; Fig. 11; Paragraphs [0076] through [0100] and Paragraphs [0387] through [0402])

Claims 19 and 25: Lesandrini discloses the method and system according to claims 17 and 23, further comprising the step of: analyzing collected data. (Fig. 9; Fig. 11; Paragraphs [0076] through [0100]; Paragraphs [0343] through [0350]; and Paragraphs [0387] through [0402])

Claims 20 and 26: Lesandrini discloses the method and system according to claims 19 and 25, further comprising the step of: displaying locations of all point-and-click data collected for the advertisement. (Fig. 9; Fig. 11; Paragraphs [0076] through [0100]; Paragraphs [0343] through [0350]; and Paragraphs [0387] through [0402])

Claims 21 and 27: Lesandrini discloses the method and system according to claims 19 and 25, further comprising the steps of: displaying percentage of point-and-click data collected for various sections of the advertisement. (Fig. 9; Fig. 11; Paragraphs [0076] through [0100]; Paragraphs [0343] through [0350]; and Paragraphs [0387] through [0402])

Claims 22 and 28: Lesandrini discloses the method and system according to claims 19 and 25, further comprising the step of: transforming word responses into point-and-click data for display. (Fig. 9; Fig. 11; Paragraphs [0076] through [0100]; Paragraphs [0343] through [0350]; and Paragraphs [0387] through [0402])

Response to Arguments

6. Applicant's arguments filed November 6 2009 have been fully considered but they are not persuasive. The applicant argues that Lesandrini et al. does not disclose asking the user to point and click on at least one feature of the advertisement while the advertisement is being displayed. However, the applicant is inferring limitations which

are not positively recited in the claims. The claims disclose displaying an advertisement. There is no limitations in the claims that require the advertisement to have more than one feature associated with it. Therefore, requesting the user to react to the advertisements by pointing and clicking the on at least one feature is no more limiting than requesting the user to click on the advertisement. However, Lesandrini specifically states in paragraph [0037] that the user is selecting and advertisement to be viewed. Thus, it is clear that the advertisement requires clicking in order to activate the advertisement. Lesandrini further discloses in paragraph [0094] that users earn points for viewing commercials. Thus it is clear that the clicking of the advertisement for viewing is being collected. Lesandrini further discloses in paragraph [0100] that the user clicks on a color wheel to select a color that they associate with an advertisement and then enter the meaning of the color thus they are disclosing click data that includes a feature such as the feeling an advertisement invokes. Thus it is clear that data is being collected regarding the color the user clicked on and the meaning of said identified color as it relates to the advertisement displayed. Lesandri further discloses tracking click-through data regarding the advertisements displayed in Paragraphs [0514] and [0518]. Thus Lesandrini is collecting point and click data on at least one feature of an advertisement while the advertisement is being displayed. It appears the applicant is attempting to claim an invention in which an advertisement that contains a certain number of features that are identifiable based upon the location of the feature in the advertisement is displayed to a user, and the user selects which of the features contained in the advertisement is of most interest to them. The users response is

somehow transmitted to a storage device and then a question posed in some manner to the user. However, the breadth of the claims is currently much broader than this. For example, claim 17 merely requires displaying an advertisement on a website and gathering information from a user regarding the advertisement. Therefore, the claim could be interpreted as broadly as displaying an advertisement on a website and a focus group leader asking the user to point to the feature of the advertisement that they like the most, the group leader then writes the data down so that it is stored, and the group leader then asks the user another question. The types of questions and the responses in the interpretation are merely a matter of design choice or intended use and have little if any patentable weight. The examiner suggests specifically detailing the features of the advertisement, how the requests are made, by what apparatus the requests are made, how responses to the requests are received, and the apparatus used to receive the response, how the response is stored, and any relevant apparatus associated with said storage, and how a question is determined based upon said response and how the question is transmitted and posed to the user. Additionally, Claim 23 interpreted in its broadest form is merely directed towards a system including a computer and a storage device that are for accomplishing a task. The claim indicates what the apparatuses intended use is for, but the claimed use does not impose any structural limitations on the claimed system and as such are given little if any patentable weight.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **JOHN VAN BRAMER** whose telephone number is (571)272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John Van Bramer/
John Van Bramer
Primary Examiner, Art Unit 3622